

REMARKS

Response to Restriction Requirement

The Examiner restricts the claims and requires election of one of the following groups:

- I. Claims 1-19, drawn to a surface imprint composition comprising a matrix material defining imprints of a template molecule wherein a substantial fraction of the imprint cavities are located at or near the surface of the matrix material.
- II. Claims 20-26, drawn to a plurality of the surface imprint compositions.
- III. Claim 27, drawn to a surface imprint composition comprising a matrix material defining imprints of a template molecule wherein a substantial fraction of the imprint cavities are oriented.

As stated a MPEP §803, there are two criteria for a proper restriction requirement between patentably distinct inventions:

- (A) The inventions must be independent or distinct as claims; and
- (B) There must be a serious burden on the examiner if restriction is required.

Applicant submits that examination of Groups I and III together would place no serious burden on the Examiner. Since the claims of Groups I and III are classified under the same class and subclass, search and examination of the claims of these groups should not be especially burdensome. Since the classification is the same and the field of search is the same, there is no clear indication of why such inventions should be divided. The Examiner has justified the restriction stating "Invention I does not require imprint cavities to be oriented as required in Invention III and Invention III does not require a substantial fraction of imprint cavities to be at or near the surface as required in Invention I." However, such a statement does not demonstrate how the search for Group I require search in places where no pertinent art to Group III exists. Each of the claimed surface imprints shares several common features: that it is a surface imprint, that it comprises a matrix material, and that the matrix material define imprint cavities of a

template molecule. Thus, Applicant submits that examination of Groups I and III will require coextensive searches. Accordingly, Applicant requests the Examiner to withdraw the division of Groups I and III. The claims of Group I are elected, however, pending the consideration of this traversal. Claims 20-26 are withdrawn from consideration without prejudice.

Amendment and Response to Notice to Comply

In response to the Notice to Comply with Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures, dated May 1, 2003, Applicant respectfully submits the following amendments and remarks. At the time of filing the present application, Applicant requested that the Sequence Listing in computer readable form from prior Application Serial No. 09/507,299, filed 18 February 2000, be made part of the present application as provided by 37 C.F.R. §1.821(e). The sequences disclosed in the present application are identical to those disclosed in the referenced Sequence Listing. In addition, a paper copy of the Sequence Listing from Application Serial No. 09/507,299 was included with the present application. Therefore Applicants submit that the requirements for patent applications containing amino acid sequence disclosures were fulfilled as of the filing date of the present application.

However, to expedite prosecution of this application, Applicants submit a new Sequence Listing in both computer-readable and paper format. In compliance with Requirements for Nucleotide Sequence and/or Amino Acid Sequence Disclosures, the present specification is amended to identify amino sequences by their SEQ ID NOs. These amendments include no new matter.

Also attached is a computer readable copy of the "Sequence Listing." The content of the copy in computer readable form is identical to the content of the paper copy of the "Sequence Listing".

Appl. No. 09/970,641
Response/Amendment dated 23 May 2003
Reply to Office Action of 1 May 2003

Reference to co-pending application by U.S. Serial No.

A co-pending patent application is identified in the specification by attorney docket number. The specification is amended to identify the referenced co-pending application by its U.S. Serial Number. No new matter is included by these amendments.

If in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned at (650) 843-5226.

Dated: 23 May 2003

Cooley Godward LLP
ATTN: Patent Group
Five Palo Alto Square
3000 El Camino Real
Palo Alto, CA 94306-2155
Tel: (650) 843-5000
Fax: (650) 857-0663

Respectfully submitted,
COOLEY GODWARD LLP

By:


Karen E. Flick
Reg. No. 44,111

646990 v1/PA
DV7Y011.DOC